REMARKS

In response to the above-identified Office Action, Applicant seeks reconsideration in view of the following remarks. In this response, Applicant does not cancel, add or amend any claims. Accordingly, claims 1-17 are pending.

I. Claims Rejected Under 35 U.S.C. § 102

Claim 10 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,668,966 issued to Ono, et al. (hereinafter "Ono"). Applicant respectfully disagrees for the following reasons.

It is axiomatic that to anticipate a claim, the Examiner must show that each element of the claim is taught by a single reference. In regard to claims 1 and 12, these claims include the elements of "defining a library of available criteria." The Examiner cites the Abstract and col. 4, lines 53-59 of Ono as teaching "defining a library of available criteria." The Examiner further argues "in the composite predicate production of Ono, the mere retention of a group of such primitives in some form of buffered storage prior to their conjunction is enough to read upon a reasonably broad interpretation of 'library of available criteria,' which is a stored collection that is accessed at a later time." Applicant disagrees. Applicant believes that the Examiner's definition of a library as a stored collection that is accessed at a later time is contrary to the common usage of the term by those of ordinary skill in the art. Further, temporary buffering of a set of user defined predicates does not teach providing a library of "available criteria." The Examiner has not provided any explanation as to how a set of user defined predicates and buffered storage has any correspondence to what the available criteria are for a filter for a population of items.

A claim is given the broadest reasonable interpretation, but this interpretation must be consistent with the interpretation that those skilled in the art would reach. See *In Re Cortright*, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). See also MPEP § 2111.01. A library is defined as a "collection of pre-compiled routines that a program can use." See the definition of 'Library' in the Webopedia at www.webopedia.com/term/l/library/html. In the context of claims 1 and 12, one of ordinary skill in the art would understand that a "library of available criteria" connotes a collection

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of criteria that has been pre-compiled and provides a set of standard options. Further, one of ordinary skill in the art would understand that a library connotes a standard and relatively permanent collection. The Examiner admits that the composite predicate taught by Ono retains a group of primitives only temporarily in a buffered storage prior to conjunction. See page 4 in the Office Action. The Examiner's interpretation of a temporary stored collection of primitives that are not reusable as a "library" of available criteria is so broad as to render the term "library" meaningless. Proper interpretation of the claims provides words with the broadest reasonable claim meaning as understood by one of ordinary skill in the art. The term "library" as used in the context of claims 1 and 12 would be understood by one skilled in the art to be a collection of permanent standard items. Thus, the ephemeral collection of user defined primitives assembled by Ono does not read on a library.

Further, the collection of primitives in a buffered storage relied upon by the Examiner does not constitute a library of "available criteria." The primitives of Ono are input by a user using a "create primitive" command. See col. 10, lines 47-64 of Ono. The primitive creation command of Ono provides an open ended input system where the user can use the create primitive command to input any primitive into the system. Thus, the primitive that is input by a user in the system of Ono does not have any correspondence to a set of "available criteria" as claimed in claims 1 and 12. Thus, Applicant believes that Ono does not teach providing a library of available criteria. Thus, Applicant does not believe the Examiner has established that Ono teaches each of the elements of claims 1 and 12. Accordingly, reconsideration and withdrawal of the anticipation rejection of claims 1 and 12 are requested.

In regard to claims 2-4, 7, 10, 11, 13-15 and 17, these claims depend from independent claim 1 and 12 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to independent claims 1 and 12, these claims are not anticipated by Ono. Accordingly, reconsideration and withdrawal of the anticipation rejection of these claims are requested.

II. Claims Rejected Under 35 U.S.C. § 103

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ono. Applicant respectfully disagrees for the following reasons.

To establish a *prima facie* case of obviousness, the Examiner must show the cited references, combined, teach or suggest each of the elements of the claims. In regard to claims 5 and 6, these claims include the elements of "a tally of the list of items of interest" and "displaying a tally of a list." The Examiner admits that Ono does not explicitly teach a numerical tally. The Examiner now argues that in Ono's "filtering of a collect via a search, an answer set is invariably returned, this having a size or item count. The characteristic of search results to assume these varying magnitudes would have provided the motivation needed to one skilled in the art to supply the missing 'tally'." The Examiner's argument that when an answer set is returned, a size or item count is automatically present is a *non sequitur*. A search result has an inherent size, however, it is a different matter as to whether the size or item count is in fact known. To determine the size or item count of the returned search, a count or tallying procedure would have to be utilized. For example, a search algorithm may simply concatenate each found item into a file or data structure. To determine the size of such a data structure, the data structure would have to be traversed to produce an item count or tally count. The Examiner argues that the variance in size of a search result may motivate one of ordinary skill in the art to generate such a tally. However, the Examiner has provided no citation to any part of Ono that teaches the desirability of such a tally. See MPEP § 2143.01 entitled "The Prior Art Must Suggest the Desirability of the Claimed Invention." The Examiner has not provided any explanation as to how Ono teaches the desirability of this modification to its own teachings. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 5 and 6. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 5 and 6 are requested.

III. Allowable Subject Matter

Applicant notes with appreciation that the Examiner has indicated that claims 8, 9 and 16 are allowable over the prior art that has been made of record. For the reasons set forth above,

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Applicant now believes that these claims are now in condition for allowance. Accordingly, reconsideration and withdrawal of the objection to claims 8, 9 and 16 are requested.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1-17 patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION:
I hereby certify that this paper is being facsimile transmitted to the U.S. Patent and Trademark Office on September 2, 2004.

9-2-04

Lillian E. Rodriguez   September 2, 2004